

REMARKS

Summary of Office Action

Claims 82-108 and 120-150 were pending in this application prior to entry of the foregoing amendments.

Claims 97, 99-100, 139 and 141-142 were withdrawn from consideration as being directed to nonelected species.

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26, 42-43, 49-50 and 82 of copending Application No. 09/858,457 (hereinafter "the '457 application").

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/775,259 (hereinafter "the '259 application").

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-130 of copending Application No. 10/723,911 (hereinafter "the '911 application").

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 were provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 26-55 of copending Application No. 10/817,713 (hereinafter "the '713 application").

Claims 82, 86, 88-90 and 106-107 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bruhwiler U.S. Patent 5,209,086 (hereinafter "Bruhwiler").

Claims 82, 85-86, 88-92, 94-96 and 105-107 were rejected under 35 U.S.C. § 102(b) as being anticipated by Holmgren U.S. Patent 5,588,315 (hereinafter "Holmgren").

Claims 82-86, 88-92, 94-96 101-108, 120-125, 127-134, 136-138 and 143-150 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burdett et al. U.S. Patent 5,944,185 (hereinafter "Burdett").

Claims 87, 93, 126 and 135 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruhwiler, Holmgren or Burdett in view of Lax U.S. Patent 5,768,922 (hereinafter "Lax").

Claims 98 and 140 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burdett in view of Belden et al. U.S. Patent 5,996,788 (hereinafter "Belden").

Summary of Applicants' Reply

Applicants have canceled claims 82-108 and 125, and expressly reserve the right to pursue the subject matter of

canceled claims 82-108 and 125 in one or more continuation applications, for example.

Applicants have amended claim 120 to more particularly define the claimed invention.

Applicants have filed a Terminal Disclaimer upon the issuance of patents on the applications identified by the Examiner in the provisional obviousness-type double patenting rejections.

Applicants traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) of claims 120-150.

Applicants request acknowledgement of consideration of a reference translation.

Applicants have included an interview summary.

Applicants' Reply to the Provisional Obviousness-Type Double Patenting Rejections

The Examiner provisionally rejected claims 82-96, 98, 101-108 (all of which were canceled by the foregoing amendment), 120-138, 140 and 143-150 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26, 42-43, 49-50 and 82 of the '457 application, claims 1-25 of the '259 application, claims 1-130 of the '911 application and claims 26-55 of the '713 application.

Applicant herewith submits a Terminal Disclaimer Under 37 C.F.R. § 1.321(b,c) disclaiming the terminal portion of any patent issued on the above-identified Application No. 10/763,332 that would extend beyond the term of any patent issued on any of copending Applications Nos. 09/858,457; 10/775,259; 10/723,911; and 10/817,713, and acknowledging that said above-identified Application No. 10/763,332 will be enforceable only so long as title to any of said above-identified Applications Nos. 09/858,457; 10/775,259; 10/723,911; and 10/817,713 is the same as title to said copending Application No. 10/763,332.

For these reasons, applicants respectfully submit that the provisional double-patenting rejections have been overcome.

Applicants' Reply to the § 102(b) Rejection over Burdett of Claims 82-86, 88-92, 94-96 101-108, 120-125, 127-134, 136-138 and 143-150

Claims 82-86, 88-92, 94-96, 101-108, 120-125, 127-134, 136-138 and 143-150 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burdett.

Applicants have canceled claims 82-86, 88-92, 94-96, 101-108 and 125. Accordingly, the Examiner's rejections of these claims under 35 U.S.C. § 102(b) are now moot.

Applicants' independent claim 120, as amended, is directed to a system for locking an item. Claims 121-124, 127-134, 136-138 and 143-150 depend directly or indirectly from claim 120. Claim 120 requires a containing element that has first and second enclosing members to enclose the item. The claim also requires a lock that has a base and a first catch mechanism. The base includes a portion configured to move inside the closed containing element. The first catch mechanism is attached to the portion and configured to be moved relative to [the] portion by a magnetic field, and comprises "a component that is, in the presence of said magnetic field, subject to a magnetic force and is configured to be located inside said containing element when said containing element is closed" (claim 120 at lines 12-16, emphasis added).

The Examiner alleged that Burdett shows all of the features of applicants' independent claim 120. The Examiner alleged in a first alternative (hereinafter "alternative A") that Burdett shows "a lock having a base portion 212 in FIG. 24 received within a portion 72 of the containing element" and first and second catch mechanisms 216 (Office Action, p. 5, ¶ 3). The Examiner alleged in a second alternative (hereinafter "alternative B") that Burdett shows a lock having "a base 212 having a portion 214 received

within the containing element" and first and second catch mechanisms 216 (Office Action, p. 5, ¶ 3).

In both alternatives identified by the Examiner, the magnetically attractive portion, metal clip 242, is not "located inside the containing element when the containing element is closed," as required by applicants' independent claim 120. Instead, metal clip 242 moves inside lock 260 and remains outside of box 10, as shown in FIG. 24.

Applicants submit that, for the foregoing reasons, and contrary to the Examiner's contention, Burdett does not show or suggest all of the features of applicants' claim 120. This claim is therefore allowable over Burdett, and dependent claims 119-124, 127-134, 136-138 and 143-150, which depend from claim 120, are also allowable over Burdett. Accordingly, applicants respectfully request the rejection of claims 120-124, 127-134, 136-138 and 143-150 under 35 U.S.C. § 102(b) be withdrawn.

Applicants' Reply to the § 103(a) Rejections

A. Claims 87, 93 and 98

Applicants have canceled claims 87, 93 and 98. Accordingly, the Examiner's rejections of these claims under 35 U.S.C. § 103(a) are now moot.

B. Claims 126 and 135

Claims 126 and 135 were rejected under 35 U.S.C § 103(a) as being unpatentable over Bruhwiler, Holmgren or Burdett in view of Lax.

Claims 126 and 135 depend indirectly from independent claim 120. As discussed above, Burdett does not show the claim 120 feature of a catch mechanism having "at least one component subject to a magnetic force when said catch mechanism is in the presence of said magnetic field and configured to be located inside said containing element when said containing element is closed." Lax shows a lock having magnets 62 that move inside the lock and that do not extend into case 21 (Lax FIGS. 7A-7C). Lax therefore does not show applicants' claimed feature of a catch mechanism having "at least one component subject to a magnetic force when said catch mechanism is in the presence of said magnetic field and configured to be located inside said containing element when said containing element is closed" (claim 120) and does not make up for the deficiency of Burdett.

Bruhwiler is directed to an anti-theft apparatus for a container having a slide-in opening (col. 3, ll. 18-20, FIG. 1). Bruhwiler therefore fails to show or suggest applicants' claimed feature of a "containing element including first and second enclosure members" (claim 120).

The container in the Lax system has a slide-in opening instead of two enclosure members. Lax therefore does not show applicants' claimed feature of a "containing element including first and second enclosure members" (claim 120), and fails to make up for the deficiency of Bruhwiler.

Holmgren is directed to a safety device to be mounted on a box to secure an item contained in the box (col. 1, ll. 4-10). The safety device includes a lock, but does not include a container with two enclosure members. Holmgren therefore fails to show or suggest applicants' claimed feature of a containing element having "first and second enclosure members, [the] container configured to enclose an item" (claim 120). Lax, as described above, does not show this claimed feature. Lax therefore fails to make up for the deficiency of Holmgren.

Applicants respectfully submit, for the foregoing reasons, that the combinations of any of Burdett, Bruhwiler or Holmgren with Lax fails to show all of the features of independent claim 120. Because claims 126 and 135 depend from claim 120, claims 126 and 135 are also patentable.

C. Claim 140

Claim 140 was rejected under 35 U.S.C § 103(a) as being unpatentable over Burdett in view of Belden.

Burdett, as discussed above, does not show applicants' claimed feature of a catch mechanism having "at least one component subject to a magnetic force when said catch mechanism is in the presence of said magnetic field and configured to be located inside said containing element when said containing element is closed" (claim 120). Belden is directed to a storage container with a central hub (col. 1, ll. 12-22). Belden does not show or suggest a lock for locking the storage container. Therefore, Belden does not show or suggest applicants' claimed feature of a catch mechanism having "a component that is, in the presence of said magnetic field, subject to a magnetic force and is configured to be located inside said containing element when said containing element is closed", and thus does not make up for the deficiency of Burdett.

Applicants submit, for the foregoing reasons, the combination of Burdett and Belden fails to show all of the features of independent claim 120. Because claim 140 depends from claim 120, claim 104 is also allowable.

Accordingly, applicants respectfully request the rejection of claims 126, 135 and 140 under 35 U.S.C. § 103(a) be withdrawn.

**Request for Acknowledgement of
Consideration of Reference Translation**

With the April 1, 2005 Office Action, the Examiner returned a copy of a Form PTO-1449 submitted by the applicants. A line showing that a translation of European Patent No. 0616103 was submitted for consideration was struck. Based on a May 5, 2005 telephonic interview between the undersigned and the Examiner regarding parent Application No. 09/858,457, in which an identical line on a corresponding Form PTO-1449 was struck, applicants understand that in the instant application the Examiner considered the translation but then struck the translation from the Form to cancel a duplicate listing of European Patent No. 0616103. Applicants respectfully request that the Examiner acknowledge in his next communication that the translation of the European Patent was considered with respect to the instant application.

Interview Summary

The April 1, 2005 Office Action included a statement that a Form PTO-892 listing references related to applicants' invention but not relied upon was enclosed. However no such form was enclosed with the Office Action and

the Examiner confirmed in a June 7, 2005 telephonic interview with the undersigned that the statement was erroneous.

Conclusion

Applicants respectfully submit that, for at least the foregoing reasons, claims 120-138, 140 and 143-150 are allowable and that this application is in condition for allowance. Reconsideration and prompt allowance are respectfully requested.

Respectfully submitted,


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